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Date of Deposit: September 27, 2007



PATENT
CASE NO. 8285/431

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Philip T. Kortum)
Serial No. 09/847,045) Examiner: Igor N. Borissov
Filing Date: May 1, 2001) Group Art Unit No. 3629
For Unified Digital Subscriber Line Self-)
Installation Process and Kit)

SECOND APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sirs:

This Second Appeal Brief is filed based on the non-final Office Action mailed July 7, 2007, which was sent in response to Appellant's first Appeal Brief mailed February 15, 2007. The non-final Office Action cites a new reference, "Using Your Gateway PC", which has deficiencies like the reference it replaced.

Appellant is initiating a new appeal by filing a notice of appeal under 37 CFR 41.31 and this Second Appeal Brief under 37CFR 41.37. The previously paid notice of appeal fee and appeal brief fee should be applied to this new appeal.

I. Real Party in Interest

The real party in interest for the above-referenced application is SBC Technology Resources, Inc., whose address is 9505 Arboretum Boulevard, Austin, Texas 78759. See Reel/Frame 012095/0875.

II. Related Appeals and Interferences

The undersigned is unaware of any other appeals or interferences that will directly affect, be directly affected by or have any bearing on the Board's decision in the pending appeal.

III. Status of Claims

Claims 2, 9, 17 and 21 are canceled.

Claims 1, 3-8, 10-16 and 18-20 are pending and stand non-finally rejected.

All of rejected claims 1, 3-8, 10-16 and 18-20 are appealed.

IV. Status of Amendments

No amendments are pending.

V. Summary of Claimed Subject Matter

In the claimed embodiments, a digital subscriber line (DSL) self installation kit includes at most one instruction manual which describes a unified installation process with instructions to install all of a digital subscriber line modem, at least one digital subscriber line filter, and a computer readable connection software code. (E.g., p. 1, lines 17-18). The system disclosed can help address the shortcomings of prior systems, such as systems that included a separate instruction manual for each unit in the kit, which led to an undesirably high rate of failures and frustration for customers who attempted to self-install DSL. These failures lead to help desk calls and, in certain cases, the dispatch of technicians to the customer's premises.

Independent claim 1 recites a digital subscriber line self installation kit. (See e.g., Fig. 4 and p. 4, lines 15-21). The kit includes a digital subscriber line modem, at least one digital subscriber line filter, and a computer readable medium whose contents

comprise computer readable connection software code. (See e.g., Figs. 1 and 3 and p. 2, lines 4-9 and p. 4. lines 22-31). The kit also includes at most one instruction manual which describes a unified installation process. The unified installation process provides instructions to install all of the digital subscriber line modem, the at least one digital subscriber line filter, and the computer readable connection software code. (See e.g., page 5, lines 5-22). The at most one instruction manual requires no operating system selection by a user and corresponds to an operating system of the user. (p.5, lines 23-31)

Independent claim 8 recites a digital subscriber line self installation kit. (See e.g., Fig. 4 and p. 4, lines 15-21). The kit includes a network card, a digital subscriber line modem, at least one digital subscriber line filter, and a computer readable medium whose contents comprise computer readable connection software code. (See e.g., Figs. 1 and 3 and p. 2, lines 4-9 and p. 4. lines 22-31). The kit also includes at most one instruction manual which describes a unified installation process. The unified installation process provides instructions to install all of the network card, the digital subscriber line modem, the at least one digital subscriber line filter, and the computer readable connection software code. (See e.g., page 5, lines 5-22). The at most one instruction manual requires no operating system selection by a user and corresponds to an operating system of the user. (p.5, lines 23-31)

Independent claim 16 recites a digital subscriber line self installation kit. (See e.g., Fig. 4 and p. 4, lines 15-21). The kit includes a network card, a digital subscriber line modem, at least one digital subscriber line filter, and a computer readable medium whose contents comprise computer readable connection software code. (See e.g., Figs. 1 and 3 and p. 2, lines 4-9 and p. 4. lines 22-31). The kit also includes at most one instruction manual which describes a unified installation process. The unified installation process provides instructions to install all of the network card, the digital subscriber line modem, the at least one digital subscriber line filter, and the computer readable connection software code. (See e.g., page 5, lines 5-22). The at most one instruction manual requires no operating system selection by a user and corresponds to an operating system of the user. (p.5, lines 23-31)

VI. Ground of Rejection to be Reviewed on Appeal

Whether claims 1, 3-8, 10-16 and 18-20 are unpatentable under 35 U.S.C. 103(a) in view of the combination of "SBC global network DSL: Customer Self Install" (SBC Document) and "Using Your Gateway PC" (Hereinafter Guide).

VII. Argument

Appellant submits that the pending rejections fail to cite references teaching or suggesting all of the claimed features.

A. Ground

Appellant submits that the rejection of claims 1, 3-8, 10-16 and 18-20 under 35 U.S.C. 103(a) in view of the combination of the SBC Document and the Guide should be withdrawn. The references, even with the addition of the newly cited Guide reference, continue to fail to disclose or suggest, alone or in combination, the claimed "instruction manual which describes a unified installation process" in which the instruction manual provides "instructions to install all of the network card, the digital subscriber line modem, the at least one digital subscriber line filter, and the computer readable connection software code".

Claim 1

Pending independent claim 1 recites a digital subscriber line self-installation kit with "at most one instruction manual which describes a unified installation process which provides instructions to install all of the digital subscriber line modem, the at least one digital subscriber line filter, and the computer readable connection software code".

The SBC Document related to installing digital subscriber lines. The Office Action correctly points out that the SBC Document does not describe at most one instruction manual for the installation process of the digital subscriber lines. The SBC Document also does not disclose or suggest that the at most one instruction manual provides instructions to install all of the digital subscriber line modem, the at least one digital line filter, and the computer readable connection software. As described in the Background section of the application as filed, multiple instructions manuals, one for each different part of the system, were provided in the past.

The Guide fails to fill the gaps. The Guide is for a Gateway personal computer. While the Guide includes information for connecting a keyboard, mouse, speakers, microphone, CD player, joystick, monitor, printer, radio, TV antenna, power cord and phone line to the computer, it does not disclose instructions for connecting a digital subscriber line modem, a digital subscriber line filter and/or a computer readable connection software code. Indeed, no digital subscriber line modem or digital subscriber line filter are disclosed, and the extent of reference to a modem is that one must be installed in the system and properly connected to access the Internet. If a modem was ordered with the computer, it was preinstalled. See pg. 89. Therefore, neither reference, alone or in combination, disclose or suggest "at most one instruction manual which describes a unified installation process which provides instructions to install all of the digital subscriber line modem, the at least one digital subscriber line filter, and the computer readable connection software code".

For at least these reasons, Appellant respectfully requests that the rejections to the claims be withdrawn and the claims be considered allowable.

Claims 5-7 depend from claim 1, and are submitted to be allowable for at least the same reasons as provided for claim 1.

Claim 8

Pending independent claim 8 recites a digital subscriber line self-installation kit with "at most one instruction manual which describes a unified installation process which provides instructions to install all of the network card, the digital subscriber line modem, the at least one digital subscriber line filter, and the computer readable connection software code". For at least the reasons discussed above with regard to claim 1, Appellant respectfully requests that this rejection also be withdrawn. Claims 12-15 depend from claim 8, and are submitted to be allowable for these same reasons.

Claim 16

Pending independent claim 16 recites a digital subscriber line self-installation kit with "at most one instruction manual which describes a unified installation process which provides instructions to install all of the network card, the digital subscriber line modem, the at least one digital subscriber line filter, the computer readable connection software code and the computer readable internet service provider specific software

code". For at least the reasons discussed above with regard to claim 1, Appellant respectfully requests that this rejection also be withdrawn. Claim 20 depends from claim 16, and is submitted to be allowable for at least these same reasons.

CONCLUSION

For the reasons provided above, Appellant submits that claims 1, 3-8, 10-16 and 18-20 are allowable over the cited art. Appellant respectfully submits that the outstanding rejections of the claims as unpatentable is in error and should be reversed.

Respectfully submitted,



Vincent J. Gnoffo
Registration No. 44,714
Attorney for Appellant

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4200

VIII. Claims Appendix

1. A digital subscriber line self installation kit comprising:
 - a digital subscriber line modem;
 - at least one digital subscriber line filter;
 - a computer readable medium whose contents comprise computer readable connection software code; and
 - at most one instruction manual which describes a unified installation process which provides instructions to install all of the digital subscriber line modem, the at least one digital subscriber line filter, and the computer readable connection software code, wherein the instruction manual requires no operating system selection by a user and wherein the at most one instruction manual corresponds to an operating system of the user.
3. The kit of claim 1 further comprising a container which contains the digital subscriber line modem, the at least one digital subscriber line filter and the computer readable medium.
4. The kit of claim 3 wherein the container contains the instruction manual.
5. The kit of claim 1 wherein the instruction manual provides a point of contact telephone number associated with the digital subscriber line modem.
6. The kit of claim 1 wherein the instruction manual provides a point of contact telephone number associated with the at least one digital subscriber line filter.
7. The kit of claim 1 wherein the instruction manual provides a point of contact telephone number associated with the computer readable connection software code.
8. A digital subscriber line self installation kit comprising:
 - a network card;
 - a digital subscriber line modem;
 - at least one digital subscriber line filter;

a computer readable medium whose contents comprise computer readable connection software code; and

at most one instruction manual which describes a unified installation process which provides instructions to install all of the network card, the digital subscriber line modem, the at least one digital subscriber line filter, and the computer readable connection software code, wherein the instructions manual requires at most one operating system selection by a user, wherein the operating system selection step comprises selecting the at most one instruction manual.

10. The kit of claim 8 further comprising a container which contains the network card, the digital subscriber line modem, the at least one digital subscriber line filter and the computer readable medium.

11. The kit of claim 10 wherein the container contains the instruction manual.

12. The kit of claim 8 wherein the instruction manual provides a point of contact telephone number associated with the network card.

13. The kit of claim 8 wherein the instruction manual provides a point of contact telephone number associated with the digital subscriber line modem.

14. The kit of claim 8 wherein the instruction manual provides a point of contact telephone number associated with the at least one digital subscriber line filter.

15. The kit of claim 8 wherein the instruction manual provides a point of contact telephone number associated with the computer readable connection software code.

16. A digital subscriber line self installation kit comprising:

a network card;

a digital subscriber line modem;

at least one digital subscriber line filter;

at least one computer readable medium whose contents comprise computer readable connection software code and computer readable internet service provider specific software code; and

at most one instruction manual which describes a unified installation process which provides instructions to install all of the network card, the digital subscriber line modem, the at least one digital subscriber line filter, the computer readable connection software code and the computer readable internet service provider specific software code, wherein the instruction manual requires at most one operating system selection step by a user, wherein the operating system selection step comprises selecting, from the at most one instruction manual, a section of the instruction manual corresponding to an operating system of the user.

18. The kit of claim 17 further comprising a container which contains the network card, the digital subscriber line modem, the at least one digital subscriber line filter and the at least one computer readable medium.

19. The kit of claim 18 wherein the container contains the instruction manual.

20. The kit of claim 16 wherein the instruction manual provides a point of contact telephone number provider specific software code.

IX. Evidence Appendix

None

X. Related Proceedings Appendix

None